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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/710,143	11/10/2000	Erin M. Bourke-Dunphy	MS160275.1	4603

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EXAMINER

NGUYEN BA, HOANG VU A

ART UNIT	PAPER NUMBER
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2192

DATE MAILED: 05/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/710,143	BOURKE-DUNPHY ET AL.	
	Examiner	Art Unit	
	Hoang-Vu A. Nguyen-Ba	2192	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on April 17, 2006 has been entered.
2. Claims 1-21 are now pending. Claims 1, 7, 8 and 15 are independent claims.

Response to Arguments

3. Applicants' arguments in the Remarks filed concurrently with the RCE have been fully considered but are moot in view of the new grounds of rejection presented hereinafter.

Drawings

4. The drawings filed November 10, 2000 are accepted by the examiner.

Specification

5. The specification is objected to because of the following minor informalities:
 - a. The Abstract recites "[t]he location scenario further may be employed" at line 5. The recitation of the limitation is in permissive

language. First, the broadest reasonable interpretation of this limitation is that the use of the location scenario is optional feature. The use of the verb “may be” renders the claimed invention indefinite because it is unclear whether or not the location scenario is included in the subject matter of the invention. Accordingly, any arguments that this feature provides patentable distinction over the prior art will be unpersuasive. Second, the last sentence of the Abstract appears to contradict the claim that the location scenario is employed to configure the software components being mentioned at lines 2-3 of the Abstract.

b. The use of trademarks, such as Intel, Cyrix, Nexgen, Digital, Siemens, Motorola, etc. has been noted in this application (p. 12). Trademarks should be capitalized wherever they appear and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in a manner which might adversely affect their validity as trademarks.

To expedite correction on this matter, the examiner suggests the following guidelines for Applicant to follow in amending the specification:

- i. capitalize each letter of a trademark or accompany the trademark with an appropriate designation symbol, e.g., TM or ®, as appropriate;
- ii. use each trademark as an adjective modifying a description noun. For example, it would be appropriate to recite “the JAVA platform” or “the JAVA programming language.” Note that in these

examples, “platform” and “programming language” provide accompanying generic terminology, describing the context in which the trademark is used. By itself, the trademark JAVA specifies only the source of the so-labeled products, namely SUN Microsystems, Inc.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-6 and 7 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1 and 7 recite a system where all elements (e.g., an interface component, a setup component, means for identifying and means for determining) would reasonably be interpreted by one of ordinary skill in the art in light of the disclosure as software, such that the system is software, per se.

Claims 1 and 7 are thus drawn to functional descriptive material NOT claimed as residing on a computer-readable medium.

MPEP 2106.IV.B.1(a)(Functional Descriptive Material) states:

“Data structures not claimed as embodied in a computer-readable medium are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer.”

“Such claimed data structures do not define any structural or functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure’s functionality to be realized.”

Claims 1 and 7, while defining a system, does not define a “computer-readable medium” and are thus non-statutory for that reason. A system can

range from paper on which the program is written, to a program simply contemplated and memorized by a person.

“In contrast, a claimed computer-readable medium encoded with the data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure’s functionality to be realized, and is thus statutory.” — MPEP 2106.IV.B.1(a).

Claims 2-6, which depend from Claim 1, do not appear to limit the system to a computer-readable medium either. Therefore, they are also rejected under 35 U.S.C. § 101 for the same reasons.

8. Claims 15-21 are rejected under 35 U.S.C § 101 because the claimed invention is directed to non-statutory subject matter.

Claim 15 recites computer readable media. Since Applicants’ disclosure, at p. 13, lines 1-7, indicates that computer-readable media also refer to other types of media which are readable by a computer, a broad and reasonable interpretation of the computer-readable media would also include carrier wave, which is a waveform suitable for modulation by an information-bearing signal, which is indeed computer readable.

A carrier wave is clearly not a “process” under 35 U.S.C. § 101 because it is not a series of steps. The other three § 101 classes of machine, compositions of matter and manufactures “relate to structural entities and can be grouped as ‘product’ claims in order to contrast them with process claims.” 1 D. Chisum, Patents § 1.02 (1994). The three product classes have traditionally required physical structure or material.

A claimed carrier wave has no physical structure, does not itself perform any useful, concrete and tangible result and, thus, does not fit within the definition of a machine.

A claimed carrier wave is not matter, but a form of energy, and therefore is not a composition of matter.

A product is a tangible physical article or object, some form of matter, which a carrier wave is not. That the other two product classes, machine and composition of matter, require physical matter is evidence that a manufacture was also intended to require physical matter. A carrier wave, a form of energy, does not fall within one of the four statutory classes of § 101.

Accordingly, a carrier wave has no physical structure and does not perform any useful, concrete and tangible result.

Also see Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, October. 26, 2005, Annex IV(c).

Claims 16-21, which depend from claim 15, are also rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter since none of them appear to limit the computer-readable medium to a tangible one.

Claim Rejections – 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejection under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States and was published under Article 21(2) of such treaty in the English language

10. Claims 1-21 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,282,711 to Halpern et al. ("Halpern").

Claim 1

Halpern discloses at least a *system that facilitates configuration of a software system being installed, comprising:*

an interface component that obtains location scenario information pertaining to a location of a device within a network upon which the software system is to be installed (see at least 3:10-16; FIG. 1, item 106; FIG. 2, blocks 2B-1, 2B-2; and related text);

a setup component that configures the software system based at least in part upon the information pertaining to the location of the device within the network by providing at least one recommended, selectable component for installation corresponding to such location (see at least FIG. 2, blocks 2A-1, 2A-2, 3, 4, 5 and FIG. 3, blocks 6-7 and related text).

Claim 2

The rejection of base claim 1 is incorporated. Halpern further discloses *the software system further comprises a plurality of available components, the setup component selects default components for installation from the plurality of available components based on the location scenario information (see at least 5:49-67; it is noted that besides the user-selected components, the remaining components are default components that are required for a complete installation package).*

Claim 3

Rejections of base claim 1 and intervening claim 2 are incorporated.

Halpern further discloses *a component selection user interface that identifies the default components and, in response to receiving a user input, selects which of the plurality of available components of the software system are to be installed, the operating characteristics for at least some of the selected components being controlled as a function of the location scenario information* (see at least 5:6-48).

Claim 4

The rejection of base claim 1 is incorporated. Halpern further discloses *the setup component further comprises a location user interface component that presents at least two locations scenarios associated with installation of the software system, the location user interface component sets the location scenario in response to receipt of an associated user input* (see at least 3:11-16).

Claim 5

The rejection of base claim 1 is incorporated. Halpern further discloses *computer-executable instructions associated with the setup component for accessing stored system information and determining configuration characteristics associated with a location onto where the software system is being installed, the location scenario being determined based on the configuration characteristics* (see at least 3:19-38; e.g., “computer-executable instructions” is considered to read on Halpern’s programmatic links).

Claim 6

The rejection of base claim 1 is incorporated. Halpern further discloses *the software system is a server system that has a plurality of server components and the location scenario information is selected from at least two scenarios including a central server*

scenario and a branch office server scenario (see 3:11-16; the “central server scenario” and “branch office server scenario” are interpreted to read on Halpern’s system administrator and a regular user templates, respectively).

Claim 7

Claim 7 is an independent claim that recites a system for facilitating configuration of a software system being installed comprising means for performing similar method steps of claim 1. In particular, the “computer,” “yielding a default,” and “customizable subset of software system component” are considered alternative characterization of a “device,” “providing recommended” and “selectable component,” respectively of claim 1. Thus, the rejection set forth in claim 1 also applies to claim 7.

Claim 8

Claim 8 is an independent claim that recites a method for configuring a software system comprising similar method steps of claim 7. The limitation “... a device ... with respect to disparate devices” is considered to be an alternative recitation of “a computer ... within a network” in claim 7. Thus, the rejection of claim 7 also applies to claim 8.

Claim 9

The rejection of base claim 8 is incorporated. Since claim 9 recites the same feature of claim 2, the same rejection is applied.

Claim 10

Rejections of base claim 8 and intervening claim 9 are incorporated. Since claim 10 recites the same feature of user interface that identifies a default component of claim 3, the same rejection is applied.

Claim 11

Rejections of base claim 8 and intervening claims 9-10 are incorporated. Since claim 11 recites the same feature of selecting which of the plurality of available components to be installed and the operating characteristics of the selected components being controlled as a function of the location scenario information of claim 3, the same rejection is applied.

Claim 12

The rejection of base claim 8 is incorporated. Since claim 12 recites the same feature of claim 4, the same rejection is applied.

Claim 13

The rejection of base claim 8 is incorporated. Since claim 13 recites similar features as claim 5, the same rejection is applied.

Claim 14

The rejection of base claim 8 is incorporated. Since claim 14 recites similar features of claim 6, the same rejection is applied.

Claim 15

Claim 15 is an independent claim that recites, in an alternative form, a computer-readable medium having computer-executable instructions for

performing similar steps of claim 1 or claim 7. Therefore, the same rejection is applied.

Claim 16

The rejection of base claim 15 is incorporated. Since claim 16 recites similar features as claim 2, the same rejection is applied.

Claim 17

Rejections of base claim 15 and intervening claim 16 are incorporated. Since claim 17 recites computer-executable instructions for providing the same user interface that identifies a default component of claim 3, the same rejection is applied.

Claim 18

Rejections of base claim 15 and intervening claims 16-17 are incorporated. Since claim 18 recites computer-executable instructions for selecting which of the plurality of available components to be installed and the operating characteristics of the selected components being controlled as a function of the location scenario information of claim 3, the same rejection is applied.

Claim 19

The rejection of base claim 15 is incorporated. Since claim 19 recites computer-executable instructions for providing a user interface that presents two possible location scenarios of claim 4, the same rejection is applied.

Claim 20

Rejections of base claim 15 and intervening claim 19 are incorporated. Since claim 20 recites computer-executable instructions for performing the same feature of claim 6, the same rejection is applied.

Claim 21

The rejection of base claim 15 is incorporated. Since claim 21 recites computer-executable instructions for performing features that are similarly recited in claim 3, the same rejection is applied.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoang-Vu "Antony" Nguyen-Ba whose telephone number is (571) 272-3701. The examiner can normally be reached on Tuesday-Friday from 7:45 am to 6:15 pm.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Tuan Dam can be reached at (571) 272-3695.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status

information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

A handwritten signature in black ink, reading "Anthony Nguyen-Ba". The signature is fluid and cursive, with a long horizontal stroke at the end.

ANTONY NGUYEN-BA
PRIMARY EXAMINER

May 4, 2006